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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,532	01/12/2004	Volker Karl Ottmar Borschel	ACO2858US1	1322

7590 08/22/2006

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/755,532

Applicant(s)

BORSCHER ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The non-Final rejection mailed March 14, 2006 on page 2, paragraph 5 indicates that the status of parent application no. 10/096,807 as pending should be inserted into the specification such as: "This application is a divisional of application no. 10/096,807 filed March 13, 2002, **pending**, . . . [emphasis added]."

2. The informalities identified on page 2, paragraphs 6 and 7 of the non-Final rejection have been resolved by the amendment filed August 14, 2006. The 35 U.S.C. 112, second paragraph rejection has been overcome by the cancellation of claims 8, 9 and 11-16.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Nos. 11-92628 and 2000-143938 in view of European Patent No. 113,575 and Uchida et al. Patent No. 5,449,737.

Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the European patent and Uchida et al. in view of Japanese '628 and '938.

The rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed August 14, 2006 have been considered but are unpersuasive.

3. The declarations submitted in the parent application are not germane to the instant rejections since they have not been made of record herein. However, the deficiencies of the declarations as pointed out in the Final rejection mailed January 19, 2006 in the parent application are included in anticipation of their submission.

4. The substitute declaration filed January 12, 2006 in parent application no. 10/096,807 (equivalent to the declaration filed May 20, 2005 except for the further identification of the conventional epoxy resin of Comparative Example 2 as comprising a bisphenol A epoxy resin and a phenol novolac epoxy resin and the inclusion of Figure 3 which is the cut-through resistance curve of Comparative Example 2) attempts a comparison between Example 1 allegedly representative of the claims and Comparative Example 2 supposedly reflective of the closest prior art of Japanese '628 and '938.

Page 1, paragraph 2 indicates that Example 1 contains an epoxy-terminated polyoxazolidone resin and a phenolic curing agent. However, there is no revelation as to the reactants employed in the preparation of the epoxy-terminated polyoxazolidone, the particular type of phenolic curing agent, nor the amounts thereof, along with an identification of any other components in the powder coating.

5. Example 1 of the declaration does not refer to Example 1 on page 8 of the specification which contains 35-45 pbw of the reaction product of bisphenol A diglycidyl ether and MDI (i.e. 4,4'-diphenylmethane diisocyanate according to page 5, line 13), 5-15 parts by weight of phenolic hardener, less than 1 part by weight of imidazole and 45-55 pbw of additives and fillers.

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Even if Example 1 of the declarations is the same as Example 1 of the specification, the listing of ranges of the components, the lack of identification of the particular type of phenolic hardener and imidazole (specific kinds are described on page 6, lines 7-9) and the chemical names for the additives and fillers does not clearly establish what powder coating has been actually tested.

6. Example 2 of the declarations comprises a combination of bisphenol A epoxy resin and phenol-novolac epoxy resin along with dicyandiamide. The relative amounts of the materials have not been provided to corroborate whether it is representative of the closest prior art Example 1 of Japanese '628 and '938 obtained from 55 pbw of bisphenol A epoxy resin R-302, 10 pbw of bisphenol A epoxy resin R-304, and 35 pbw of cresol novolak epoxy resin EOCN-104S combined with 4.4 pbw of dicyandiamide (Japanese '628, page 6, paragraph 22 and Japanese '938, pages 6-7, paragraph 28).

7. The comparison is inconclusive unless the equivalent ratio of epoxy resin(s):curing agent is held constant to isolate the effect of the claimed epoxy-terminated polyoxazolidone resin on the cut-through resistance.

8. The evidence is not commensurate in scope with the claims regarding the myriad species encompassed by the broadly claimed curing agent which includes such functionally diverse types such as polyamines, polyamides, polythiols, polycarboxylic acids, polyols, the elected species of imidazoles, tertiary amines and quaternary ammonium halides (specification, page 6, lines 4-6). Furthermore, it is unclear what proportion of epoxy-terminated polyoxazolidone resin has been tested.

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Even if the proportion is revealed, the testing of a single concentration does not establish the criticality of the epoxy-terminated polyoxazolidone resin throughout the broadly denoted range of from 30-90% by weight in claim 2.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

rs
8/18/2006



ROBERT E.L. SELLERS
PRIMARY EXAMINER